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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,242	09/26/2000	Mark M. Ishikawa		4706

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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/670,242

Applicant(s)

ISHIKAWA ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 12 August 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: said key generation system generates a second unique data identifier for the source file, wherein said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier, and said database system associates said second unique data identifier and the second source elements with the source file, said database system deletes said unique data identifier and the source elements, said source print detection system compares the second source elements with corresponding target elements in the target file in accordance with said second unique data identifier and determines whether coincidence exists between the second source elements in the source file and the target elements in the target file, said preselected coincidence level differs from said second preselected coincidence level.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

2. Applicant's arguments, filed 12 August 2005, with respect to claim(s) 83-110 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rhoads, U.S. Patent No. 5,786,426. Applicant's amendment necessitated these new grounds of rejection.

Claim Objections

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3. Claim 92 is objected to because of the following informalities: line 2 should read "...one or more of the at least **one** external computer". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 93-95, 99-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: said key generation system generates a second unique data identifier for the source file, wherein said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier, and said database system associates said second unique data identifier and the second source elements with the source file, said database system deletes said unique data identifier and the source elements, said source print detection system compares the second source elements with corresponding target elements in the target file in accordance with said second unique data identifier and determines whether coincidence exists between the second source elements in the source file and the target elements in the target file, said preselected coincidence level differs from said second preselected coincidence level.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 94 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 94 recites, "said unique data identifier", which renders the claim vague and indefinite because it is unclear to which data identifier is being referred.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 83-93, 95-99, 101-110 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhoads, U.S. Patent No. 5,768,426. Referring to claims 83, 84, 96, 108, Rhoads discloses a graphics embedding system wherein an image is encoded in order to identify suspected copies of the original (Col. 3, line 40 – Col. 4, line 27), which meets the limitation of a data management server system that receives a source file for registration and a target file for comparison with the source file. The original image is encoded with a randomly generated 32-bit data word that is embedded in specific registration points of the image (Col. 9, line 32 – Col. 10, line 45), which meets the limitation of a key generation system that generates a unique data identifier for the source file by identifying a predetermined number source elements in the source file, a source print generation system that extracts the source elements from the source file in accordance with said unique data identifier. An n-bit identification word is embedded in the original image and

contains ownership information (Col. 6, lines 26-63 & Col. 13, lines 35-47), which meets the limitation of a data embedding system that embeds an information block into the source file, said information block including information pertaining to ownership of intellectual property rights. The original image, n-bit identification word and the randomly generated embedding signal is stored in a secure place (Col. 7, lines 27-30), which meets the limitation of a database system that stores the source file with the embedded information block, said unique data identifier, the source elements, and ownership information of the source file. When a suspect image is found, the original image is compared against the suspect image using the 32-bit embedding signal to determine if the images are the same (Col. 11, line 9 – Col. 12, line 16), which meets the limitation of a source print detection system that compares the source elements with corresponding target elements in the target file in accordance with said unique data identifier and that determines whether coincidence exists between the source elements in the source file and the target elements in the target file. If the suspect image is in fact a copy of the original, the n-bit identification word can be used to identify the owner of the original for notification purposes (Col. 27, lines 20-67), which meets the limitation of wherein the data management system accesses said ownership information to notify an owner of the source file if a preselected coincidence level exists between the source elements and the target elements.

Referring to claim 85, 97, 98, Rhoads discloses that the original image is encoded with a randomly generated 32-bit data word that is embedded in specific registration points of the image (Col. 9, line 32 – Col. 10, line 45), which meets the limitation of said source print generation system extracts the source elements being defined by element characteristics including element start position and an element initial position relative to said element start position, said

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generating said unique data identifier includes providing at least one data parameter associated with a selected characteristic of said unique data identifier and incorporating said at least one data parameter into said unique data identifier.

Referring to claim 86, Rhoads discloses an n-bit identification word is embedded in the original image and contains ownership information (Col. 6, lines 26-63 & Col. 13, lines 35-47), which meets the limitation of said information block includes user-defined information.

Referring to claims 87, 107, Rhoads discloses that the n-bit identification word can be encrypted (Col. 27, lines 12-19).

Referring to claim 88, Rhoads discloses that the n-bit identification word includes copyright information (Col. 26, lines 20-42), which meets the limitation of said information block includes information such as copyright information.

Referring to claims 88, 89, Rhoads discloses an n-bit identification word is embedded in the original image and contains ownership information (Col. 6, lines 26-63 & Col. 13, lines 35-47), which meets the limitation of mandatory compliance information in the form of identification information.

Referring to claims 91, 110, Rhoads discloses that the embedded image can be sold and distributed to authorized users (Col. 5, lines 52-59), which meets the limitation of said data management server system provides the source file with said embedded information block to authorized users associated with one or more of the at least one external computer system.

Referring to claims 92, 109, Rhoads discloses that a suspect image is searched for and found (Col. 7, lines 27-33), which meets the limitation of said source print detection system

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includes a search member that searches one or more of the at least one external computer system for target files to be compared with the source file.

Referring to claims 93, 99, Rhoads discloses generating 32 random data images to be embedded into the image (Col. 9, lines 39-43), which meets the limitation of said key generation system generates a second unique data identifier for the source file, wherein said source print generation system extracts a second predetermined number of second source elements from the source file in accordance with said second unique data identifier, and said database system associates said second unique data identifier and the second source elements with the source file.

Referring to claims 95, 101, 102, Rhoads discloses that when a suspect image is found, the original image is compared against the suspect image using the 32-bit embedding signal to determine if the images are the same (Col. 11, line 9 – Col. 12, line 16), which meets the limitation of said source print detection system compares the second source elements with corresponding target elements in the target file in accordance with said second unique data identifier and determines whether coincidence exists between the second source elements in the source file and the target elements in the target file.

Referring to claims 103, 104, Rhoads discloses that the system also works with compressed images (Col. 7, lines 27-34).

Referring to claim 105, Rhoads discloses that the randomly generated images are combined before being embedded (Col. 10, lines 11-15), which meets the limitation said extracting the source elements includes forming a concatenated string of the source elements.

Referring to claim 106, Rhoads discloses normalizing the original image before being embedded (Col. 8, line 36 – Col. 9, line 31).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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